

REMARKS

Applicant notes with appreciation the well-reasoned Office Action having a mailing date of August 11, 2004. This amendment is respectfully submitted to be fully responsive thereto.

35 U.S.C. §102(b)

Claims 1, 2, 4, 8-10 and 12-19 presently stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent 1,868,563 ("Cicourel"). Cicourel is cited as disclosing multiple key covers 1 having differently shaped tactile feature projections 5 on opposite sidewalls of the key cover and apertures which register with the opening in the key head, wherein the projections 5 are regarded as being identical on opposite sidewalls of the cover.

Anticipation may be established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Systems*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Claim 1 has been amended to define an outer wall extending between the first and second sidewalls defining a recess for receiving the head of the key therein. Claim 1 has been amended to also include the outer wall having ends that are spaced apart from the first and second edges of the first and second sidewalls, respectively. Applicant submits that Cicourel discloses an outer wall extending between the first and second sidewalls. The outer wall in Cicourel, however, does not include ends spaced apart from the first and second edges of the first and second sidewalls, respectively. As such, Applicant submits that claim 1 defines over Cicourel, as Cicourel does not disclose each and every element defined in claim 1.

Applicant respectfully requests withdrawal of the rejection of claim 1 as being anticipated by Cicourel under 35 U.S.C. §102(b).

Claims 2, 4 and 8-9 depend from claim 1 and therefore shall be construed to include every element of claim 1. 37 CFR 1.75. Applicant believes claims 2, 4 and 8-9 are allowable on the basis of dependency from allowable base claim 1. Applicant, therefore, requests withdrawal of the anticipation rejection of claims 2, 4 and 8-9 by Cicourel under 35 U.S.C. §102(b).

Claims 12-19 are product-by-process claims that incorporate by reference every element of claim 1. Applicant submits that Cicourel does not anticipate claims 12-19 on the basis that Cicourel does not disclose each and every element of the product defined in claim 1. Applicant, therefore, requests withdrawal of the anticipation rejection of claims 12-19 by Cicourel under 35 U.S.C. §102(b).

Claims 1-10 and 12-19 stand rejected under 35 U.S.C. §102(b) as being anticipated by International Deposit Certificate DM/059 931 ("DM"). The DM reference is cited as teaching numerous embodiments of key covers having apertures in the sidewalls to register with an opening in the key head. The DM reference is also cited as teaching raised circular projections on the sidewalls (referring to figure 9.3); depressed shapes on the sidewall (referring to figure 9.1); raised circular projections on the edges of the sidewalls (referring to figures 3.2, 3.3, 7.2, 8.2); and a house icon (referring to figure 6.3).

Claim 1 has been amended to further define a tactile feature integrally formed on the plane of the first sidewall. Applicant submits in a declaration provided herewith under 35 U.S.C. §1.132 that the tactile features shown in the DM reference were not integrally formed on the plane of the sidewall. Rather, each key cover disclosed in the DM reference is made from

separately formed parts. Specifically, a base key cover is produced separately from the tactile features. The tactile features are then fixedly secured to the sidewalls of the base key cover in a separate process, such as brazing. As such, Applicant submits that claim 1 defines over the DM reference, as the DM reference does not disclose a tactile feature integrally formed on the plane of the first sidewall.

Applicant respectfully requests withdrawal of the rejection of claim 1 as being anticipated by the DM reference under 35 U.S.C. §102(b).

Applicant believes claims 2, 4 and 8-9 are allowable on the basis of dependency from allowable base claim 1. Applicant, therefore, requests withdrawal of the anticipation rejection of claims 2, 4 and 8-9 by the DM reference under 35 U.S.C. §102(b).

Further, Applicant submits that the DM reference does not anticipate claims 12-19 on the basis that the DM reference does not disclose each and every element of the product defined in claim 1. Applicant, therefore, requests withdrawal of the anticipation rejection of claims 12-19 by the DM reference under 35 U.S.C. §102(b).

35 U.S.C. §103(a)

Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over either Cicourel or the DM reference, in view of Sheldon. Sheldon is cited as disclosing a ring securement used to hold multiple keys, wherein the keys have different identifiers (col. 3, lines 9-11).

Claim 11 defines a key ring having a first key encompassed by a key cover according to claim 1 and a second key encompassed by a second key cover according to claim 1 having a different tactile feature than the key cover of the first key. It is asserted by Examiner that it

would have been obvious to one of ordinary skill in the art at the time of the invention to combine multiple key covers, as disclosed in Cicourel or the DM reference, with the ring taught by Sheldon to arrive at the key ring of claim 11. Applicant respectfully disagrees.

To establish a *prima facie* obviousness rejection of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) cited in MPEP, 8th Ed., 2143.03. That is, there must be something in the prior art that suggested the combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988).

Sheldon teaches a key ring having a plurality of keys each having a key locator in the form of a flexible strip or tab held in a folded manner about an end of each key by a metal spring clip. Sheldon does not, however, teach or suggest the use of a key cover having the tactile feature integrally formed along the plane of the first sidewall. Further, neither Cicourel nor the DM reference teach or suggest the key cover having the tactile feature integrally formed along the plane of the first sidewall. As such, it is submitted that a *prima facie* obviousness rejection has not been established, as Cicourel, the DM reference and Sheldon do not teach or suggest the use of a key ring having a first key encompassed by a key cover according to claim 1 and a second key encompassed by a second key cover according to claim 1 having a different tactile feature than the key cover of the first key.

Applicant respectfully requests withdrawal of the obviousness rejection of claim 11 under 35 U.S.C. §103(a) by either Cicourel or the DM reference, in view of Sheldon.

Claims 3, 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Cicourel in view of the DM reference. It is asserted by the Examiner that it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute circular projections along the edges of the cover of Cicourel for projections 5 thereof, in view of the teaching of figures 8.2 and 8.3 of the DM reference, since any well known type of tactile indicia would function just as well in identifying a key. Applicant disagrees.

Cicourel discloses a key cover in the form of a flexible rubber cover having a circular row of projections extending outwardly from a planar face thereof. Figures 8.2 and 8.3 of the DM reference disclose a key cover having a plain planar face without any tactile indicia formed thereon. It is submitted that neither Cicourel nor figures 8.2 and 8.3 of the DM reference discloses a key cover having a tactile feature of geometric shape selected from the group consisting of: a circle, a triangle, a square, a parallelogram, a star, a cross, a house icon, an animal icon, a vehicle icon, and a human icon, as required in claim 3.

Claim 6 has been amended to further define the raised treatment along the first edge as protruding outwardly from the plane of the first sidewall. Neither Cicourel nor figures 8.2 and 8.3 of the DM reference teaches or suggests the tactile feature in the form of a raised treatment along the first edge protruding outwardly from plane of the first sidewall, as required in claim 6.

Claim 7 depends from claim 6 and shall be construed to include every element of claim 6. Applicant submits that claim 7 is allowable on the basis of dependency from allowable base claim 6.

Additionally, claims 3, 6 and 7 depend from claim 1 and therefore shall be construed to include every element of claim 1. Applicant believes claims 3, 6 and 7 are allowable on the basis of dependency from allowable base claim 1.

In light of the foregoing remarks, Applicant respectfully requests withdrawal of the rejection of claims 3, 6 and 7 under 35 U.S.C. §103(a) by Cicourel in view of the DM reference.

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Cicourel in view of Gapco or Lesko. Gapco is cited as teaching depressions (figure 4B) to identify a key. Lesko is cited as teaching depressions (17) to identify a key. The Examiner asserts it would have been obvious to substitute the depressions for the projections (5) of Cicourel, in view of the teaching of Gapco or Lesko, since either well known type of tactile feature would function just as well in identifying a key. Applicant disagrees.

Claim 5 requires that the geometric shape is formed in the plane of the sidewall of the key cover and depressed relative to the plane. Gapco teaches a spherical grip or key cover having a plurality of dimples that are depressed relative to an outer spherical surface of the grip. Gapco does not teach or suggest a geometric shape depressed relative to a plane, as the key cover in Gapco lacks a planar surface. Lesko teaches depressions formed in a plane of the key itself, but does not teach or suggest the use of a key cover. A teaching or suggestion to substitute the depressions of Gapco or Lesko for the projections (5) of Cicourel is not provided in Gapco, Lesko or Cicourel. As such, the obviousness rejection of claim 5 by Cicourel in view of Gapco or Lesko cannot stand, since these references do not include all of the limitations of claim 5 and do not teach or suggest the combination as asserted by the Examiner.

Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 5 under 35 U.S.C. §103(a) by Cicourel in view Gapco or Lesko.

Cancelled Claims

Claim 10 is cancelled.

New Claims

New claims 20-24 are respectfully submitted and believed by Applicant to define subject matter allowable over the prior art references made of record. It is submitted that no new matter is defined in claims 20-24.

Proposed Replacement Drawings

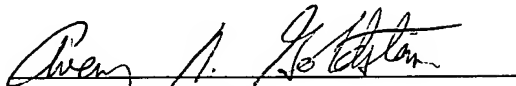
Applicant respectfully submits proposed replacement sheets believed to address the objection under 37 C.F.R. §1.83(a). Specifically, Figure 4 has been revised to show the shapes as claimed in claim 3 and claim 7. No new matter has been added to Figure 4.

Summary

Claims 1-9 and 11-19 are pending in this application. Claims 1, 6-9, 12, 17 and 19 have been amended. Claim 10 is cancelled. New claims 20-24 have been added. In light of the above remarks, it is submitted that all the pending claims are directed to allowable and patentable subject matter. Allowance of these claims and the passing of this application to issue are

solicited. Should the Examiner find to the contrary, it is respectfully requested that the undersigned attorney in charge of this application be contacted.

Respectfully submitted,



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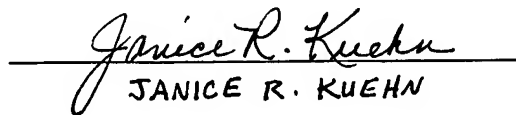
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